

REMARKS

Upon entry of this Amendment, claims 11-14 and 22-25 remain pending, with claims 11-13 and 22-25 under current examination, and claim 14 withdrawn from consideration as drawn to a nonelected invention.

In the Office Action,¹ the Examiner rejected claims 11-13 under 35 U.S.C. § 102(a) as being anticipated by Applicant's Admitted Prior Art ("APA"). Applicants traverse the rejection for the reasons that follow.

Regarding the Claim Amendments:

Applicants have amended claims 11-13 to more appropriately define the present invention, and added new claims 22-25 to protect additional aspects related to the present invention. Support for these amendments may be found in the specification at, for example, page 59, line 13 to page 61, line 4, and Figs. 23A and 23B.

Rejection of Claims 11-13 under 35 U.S.C. § 102(a):

Applicants traverse the rejection of claims 11-13 under 35 U.S.C. § 102(b) as being anticipated by APA. Applicants respectfully disagree with the Examiner's arguments and conclusions.

In order to properly establish that APA anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim."

¹ The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9

U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

APA does not disclose at least Applicants' claimed

gate electrode of the MISFET is formed on at least part of the at least one side surface and an upper surface of the island-shaped element region, the upper surface being a surface of the well region; and an electrical connection between the gate electrode of the MISFET and the well region in the semiconductor substrate formed on the upper surface of the island-shaped element region. (Claim 11.)

Instead, APA discloses gate insulating film 3505 is formed on the upper surface of well region 3503, between well region 3503 and gate electrode 3506. APA discloses that metal gate electrode 3506 is electrically connected to the well region 3503 via metal plugs 3508 and p+ type diffusion layers 3507. Thus, an electrical connection is not formed directly between the gate electrode 3506 and an upper surface of the well region 3503, because of intervening metal plugs 3508 and p+ type diffusion layers 3507. Rather, an electrical connection is formed between the gate electrode 3506 and metal plugs 3508, and in turn between metal plugs 3508 and p+ type diffusion layers 3507 to the side of the upper surface of well region 3503 that is located directly below gate insulation film 3505. See Figs. 26A and 26B and col. 2, lines 5-14. Thus, APA does not constitute the claimed "an electrical connection between the gate electrode of the MISFET and the well region in the semiconductor substrate formed on the upper surface of the island-shaped element region" (claim 11).

Further, APA does not disclose any portion of gate electrode 3506 formed on any part of a side surface and an upper surface of an island-shaped element region, assuming that items 3503, 3504, 3507, and 3505 of APA Fig. 26A are interpreted as an island-shaped element region. Instead, gate electrode 3506 is only formed on one surface of well region 3503, via gate

insulating film 3505. Thus, APA does not constitute the claimed “gate electrode of the MISFET is formed on at least part of the at least one side surface and an upper surface of the island-shaped element region, the upper surface being a surface of the well region” (claim 11).

Independent claim 11 is therefore allowable, and dependent claims 12 and 13 are also allowable at least by virtue of their dependence from allowable base claim 11. Therefore, the 35 U.S.C. § 102(a) rejection of claims 11-13 should be withdrawn.

New Claims 22-25:

In view of the reasoning presented above regarding independent claim 11, Applicants’ submit that new claim 22 is also allowable at least by virtue of its dependence from allowable base claim 11. Further, new independent claim 23 contains elements similar to those in independent claim 11, and is allowable at least in consideration of the reasoning presented above for independent claim 11. Finally, new claims 24 and 25 are allowable at least by virtue of their dependence from allowable base claim 23.

Conclusion:

In view of the foregoing, Applicants request reconsideration of the application and withdrawal of the rejections. Pending claims 11-13 and 22-25 are in condition for allowance, and Applicants request a favorable action.

If there are any remaining issues or misunderstandings, Applicants request the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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